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**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/459,138    12/10/99    JOHNSON

L    7040R

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IM31/0605

EXAMINER

TOLIN, M

ART UNIT

PAPER NUMBER

1733

DATE MAILED:

06/05/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/459,138

Applicant(s)

JOHNSON ET AL.

Examiner

Michael A. Tolin

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6 and 13-15 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12, and 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. In an interview with David Weirich on 10 May 2001, the examiner called to indicate that the current claims are broader in scope than the patented claims of the parent application which issued as U.S. Patent No. 6042673. Applicant's representative indicated that a Terminal Disclaimer would be filed in response to this office action. Accordingly, no double patenting rejections have been made here.

### *Claim Objections*

2. Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Parent claim 4 requires "folding the first member of the disposable article **about** the electromagnetic field responsive member". It is clear that claim 4 requires that the folding **after** the electromagnetic field responsive member is interposed between the opposing first proximal and first distal portions. Accordingly, the examiner's position is that claim 7 improperly removes a limitation from claim 4 by indicating folding before interposing of the electromagnetic field member.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3, 16, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the examiner suggests inserting --first-- before "member" in line 7 to clarify which member is being referenced.

Regarding claim 16, "the barrier member" lacks proper antecedent basis.

Regarding claim 20, "the secondary joining means" lacks proper antecedent basis. The examiner suggests changing the dependency of claim 20 from claim 17 to claim 18.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 7-12, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson'638 (US 5662638) in view of Kohler (US 2393541) and Heller (US 3574031).

The current Application is a CIP and the claims are not supported by any of the parent applications because the new "electromagnetic field responsive member" language is not found in the parent applications. Accordingly, the effective filing date of

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the current application is the actual filing date, 10 December 1999, and Johnson'638 therefore qualifies as prior art.

Johnson'638 teaches a method of making a flangeless seam by joining two members of a disposable article (Abstract). Johnson'638 teaches the use of joining means and a barrier member with the claimed configurations in the process of making the flangeless seam (Figs. 1-12). While Johnson'638 indicates any suitable joining means may be used (col. 12, lines 17-21), Johnson'638 does not recite joining means comprising an electromagnetic field responsive member and the claimed step of applying an electromagnetic field.

Kohler and Heller provide clear motivation for using an adhesive having susceptor particles therein, the susceptor particles being heated by an electromagnetic field to activate the adhesive. Kohler teaches that such adhesive systems may be heated to the exact temperature desired without danger of overheating or burning and that heating is limited to the bonding interface, thereby reducing the power requirements and avoiding damage to the substrates being bonded (page 1, col. 2, lines 35-50; page 2, col. 1, lines 40-50). Heller teaches that such adhesive systems are particularly suitable for bonding thin films where flexibility must be maintained, the benefits including rapid and uniform generation of heat over the entire surfaces to be bonded (col. 3, lines 20-52; col. 4, lines 15-50). It would have been obvious to one having ordinary skill in the art at the time of the invention to provide Johnson'638 with an adhesive/susceptor joining means and the claimed step of applying an electromagnetic field because one

having ordinary skill in the art would have been motivated to obtain the above stated benefits taught by Kohler and Heller.

Regarding claims 2, 3, 7, and 9, Kohler and Heller indicate that the adhesive may be applied as a film or a liquid (Kohler, page 3, col. 1, lines 1-10; Heller, col. 4, lines 15-75, col. 6, lines 10-15). Integrally connecting the adhesive/susceptor to the film of Johnson'638 prior to folding is the expected manner of applying the adhesive/susceptor system. Furthermore, one of ordinary skill would have been expected to appreciate that applying a film after folding is an equivalent manner of providing an adhesive at the desired location. Only the expected results have been achieved.

The limitation of pulling apart to form the flangeless seam is clearly taught by Johnson'638 (Figs. 3 and 4).

The claimed "secondary joining means" does not distinguish over the adhesive of the adhesive/susceptor system of Kohler or Heller.

#### ***Allowable Subject Matter***

7. Claims 6 and 13-15 are allowed and claim 16 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Regarding claim 6, no teaching or suggestion was found in the prior art of record to provide, in combination with the claimed limitations, the claimed step of removing the electromagnetic field responsive member after the first and second members are joined.

Regarding claim 13, no teaching or suggestion was found in the prior art of record to provide, in combination with the claimed limitations, the claimed step of

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providing an electromagnetic field to heat the electromagnetic field responsive member to a temperature which causes the claimed joining, wherein the electromagnetic field responsive member also prevents the joining of the first proximal and distal portions.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Johnson'589 (US 5622589) is cited of interest in the field of manufacturing disposable articles with flangeless seams.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Tolin whose telephone number is (703) 305-6618. The examiner can normally be reached on Monday-Thursday 9:30am-8pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on (703) 308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

May 15, 2001

Michael A. Tolin  
Patent Examiner

